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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Kevin E. Laracey; Krishna A. Canekaratne; Edward J. Morgan;
Brian C. Barnes; Ishan Birchett
Assignee: Siebel Systems, Inc.
Title: ELECTRONIC BILL PRESENTMENT AND PAYMENT
Application No.: 09/602,697 Filing Date: June 24, 2000
Examiner: Richard C. Weisberger Group Art Unit: 3693
Docket No.: OIC0055US Confirmation No.: 1482

Austin, Texas
October 13, 2009

Mail Stop: Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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APPEAL BRIEF

Dear Sir:

This brief is submitted in response to the Notice of Panel Decision from Pre-Appeal Brief Review dated August 10, 2009 wherein the Panel determined that Applicants should proceed to appeal. Filed herewith is a Petition for Extension of Time requesting a one month extension, thereby giving the undersigned a period until October 13, 2009 to file this appeal brief since October 10, 2009 fell on a Saturday, and the USPTO was closed October 12, 2009 for a Federal Holiday. Please charge this deposit account for any additional sums which may be required to be paid as part of this appeal.

REAL PARTY IN INTEREST

The real party in interest on this appeal is Oracle Corporation by virtue of its acquisition of Siebel Systems, Inc., the current assignee.

RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to this application.

STATUS OF CLAIMS

Claims 1-11 are pending and under final rejection. Claims 12-33 have been cancelled. Applicants appeal the final rejection of claims 1-11.

STATUS OF AMENDMENTS

Concurrently filed herewith is an amendment expressly cancelling claims 12-33. Appellants presume cancellation of these claims will be admitted under 37 CFR 41.63(a).

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 recites a computerized method of providing billing information. The method comprises acts including an act of receiving, over a communication network, a request for summary billing information, the request being automatically generated by billing portal in response to an action by a billable entity (e.g., an account holder end user) associated with the billing portal. See, e.g., Figure 6 and page 15, lines 12-14. See also page 14, lines 28-30 which describes a billing portal as one example of retail recipient 120 computer shown in Figure 6. In response to receiving the request for the summary billing information, requesting over the communication network the billing information from a supplier of the summary billing information. See, e.g., page 15, line 26 - page 16, line 2, and Figure 6. The summary billing information and detailed billing contact information from the supplier is received over the communication network. See, e.g., page 16, lines 2-14, and Figure 6. The detailed billing contact information specifies contact data for detailed billing information. See, e.g., page 16, lines 11-14, and Figures 6, 8, and 9. Lastly, the method of claim 1 requires transmitting, over the communications network to the billing portal (e.g., retail recipient 120 computer of Figure 6), the

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summary billing information and the detailed billing contact information, the detailed billing contact information to be useable by the billable entity to access the detailed billing information from a supplier of the detailed billing information. See, e.g., page 16, lines 15-24, and Figure 6.

ISSUES TO BE REVIEWED ON APPEAL

Appellants appeal the final rejection of claims 1-11 under 35 U.S.C. § 103 as being unpatentable over Market Overview: Electronic Presentment and Payment by Gillespie ("Gillespie"). Appellants appeal the use of Gillespie as prior art.

ARGUMENT

Independent claims 1-11 recite a method for providing billing information. All claims were rejected under 35 U.S.C. § 103 as being unpatentable over Gillespie.

The Use of Gillespie as Prior Art

The currently pending claims relate to a method for providing billing information. Gillespie is an article relating to Electronic Presentment and Payment (EPP). Gillespie is dated December 28, 2001. The instant application was filed on June 24, 2000, and thus predates Gillespie.

Page 11 of Gillespie lists a number of providers of EPP products. The list shows EPP start dates of providers, such as ALLTEL. For example, ALLTEL has an EPP start date of 1998. Presuming the truthfulness of the statements within Gillespie (a point to which Appellants do not concede), Appellants submit that Gillespie cannot be used a reference against the pending claims. MPEP 2124 defines the general rule that the reference date must predate the filing date of the instant application. MPEP 2124, however, lists narrow exceptions to this general rule. None of the exceptions in MPEP 2124 apply to Gillespie. Appellants submit that Gillespie should not be used a reference against claims 1-11 of the instant application.

The 35 U.S.C. § 103 Rejection of Claim 1

Independent claim 1 recites:

A computerized method of providing billing information, comprising:

receiving, over a communications network, a request for summary billing information, the request being automatically generated by a billing portal in response to an action by a billable entity associated with the billing portal;

requesting, over the communications network and in response to said receiving the request for the summary billing information, the summary billing information from a supplier of the summary billing information;

receiving, over the communications network, the summary billing information and detailed billing contact information the supplier of the summary billing information, the detailed billing contact information specifying contact data for detailed billing information; and

transmitting, over the communications network to the billing portal, the summary billing information and the detailed billing contact information, the detailed billing contact information to be usable by the billable entity to access the detailed billing information from a supplier of the detailed billing information.

Independent claim 1 recites several limitations. The final office action on the bottom of page 2 interprets the claims, which interpretation includes “a consumer logging onto a billing consolidation system and viewing the bill.” This “bill” is said by the final office action to include both the summary and detail billing information. However, there is more to independent claim 1 than merely a consumer logging on to a billing consolidation system and viewing a bill that contains summary and detail billing information. For example, independent claim 1 requires requesting summary billing information from a supplier in response to receiving a request for summary billing information from a billing portal, which in turn generated its request in response to an action by a billable entity, e.g., an account holder end user. Even if Gillespie teaches a consumer logging onto a billing consolidation system to view a bill as alleged on the bottom of page 2 of the final office action, the final office action ignores claim 1’s requirement of requesting summary billing information from a supplier in response to receiving the request for the summary billing information, which was generated in response to an action by a billable entity. Because the final office action does not allege that Gillespie’s “billing consolidation system” requests the summary billing information in response to a separate request, which in

turn was generated in response to the consumer logging onto the billing consolidation system to view a bill, the office action has failed to establish a *prima facie* basis for rejecting claim 1.

The final office action fails to establish a *prima facie* basis for rejecting claim 1 for additional reasons. Independent claim 1 recites receiving the summary billing information and detailed billing contact information, the detailed billing contact information specifying contact data for detailed billing information. The final office action states the “summary and detailed billing information” to be the single bill that is allegedly viewed by the consumer logging on to the billing consolidation system. This statement is unsupported in the final office action. Moreover, independent claim 1 recites more than receiving summary and detailed billing information. Rather, independent claim 1 recites receiving summary billing information and detailed billing contact information that specifies contact data for detailed billing information. The office action appears to ignore these limitations of the detailed billing information. In other words, the office action does not appear to address the fact that the detailed billing information includes contact information that specifies contact data for detailed billing information.

The final office action on page 3 notes claim 1’s requirement of “a request being automatically generated by billing portal in response to an action by a billable entity associated with the billing portal.” The final office action does not specifically argue that this limitation is found within Gillespie.

Independent claim 1 also requires the detailed billing contact information to be useable by the billable entity to access the detailed billing information from a supplier of the detailed billing information. The office action ignores this limitation.

The 35 U.S.C. § 103 Rejection of Claim 2

Claim 2 depends from claim 1 and further requires providing software to the billing portal prior to receiving the request for summary billing information. The final office action on page 3 argues “it would have been obvious for one skilled in the art to have software [delivered] to the bill provider and/or the bill viewer as motivated by the benefits of delivering software over the internet.” (Clarification Added) The office action fails to cite a reference which shows the delivery of software over the internet, which predates the effective filing dates of the instant application. For this reason, the final office action has failed to provide a *prima facie* basis for rejecting claim 2.

The 35 U.S.C. § 103 Rejection of Claim 3

Claim 3 is dependent from claim 2 and further requires transmitting, over the communications network, the software to the billing portal to affect delivery and installation of the software. The office action on page 3 notes this limitation of dependent claim 3, but does not allege that this limitation is found in the prior art. For this reason, the final office action has failed to provide a *prima facie* basis for rejecting claim 3.

The 35 U.S.C. § 103 Rejection of Claim 4

Claim 4 is dependent from claim 3 and further requires that the delivery, installation, and operation of the provided software are automatic with respect to other human and machine activity at the billing portal. The office action on page 3 notes this limitation of dependent claim 4, but does not allege that this limitation is found in the prior art. For this reason, the final office action has failed to provide a *prima facie* basis for rejecting claim 4.

The 35 U.S.C. § 103 Rejection of Claims 5

Claim 5 depends from claim 4 and further requires the software comprises one contiguous portion of dynamic HTML. The office action argues that the limitations of claim 5 fails to further limit the method claims. Appellants disagree. Claim 5 is dependent from claim 4, which in turn is dependent from claim 3, which depends from claim 2. Dependent claim 2 requires providing the software to the billing portal, and claim 5 further defines the software as comprising one contiguous portion of dynamic HTML, as opposed to one contiguous portion of JavaScript as recited in claim 6. Claim 5 recites positive limitations that cannot be ignored. For this reason, the final office action has failed to provide a *prima facie* basis for rejecting claim 5.

The 35 U.S.C. § 103 Rejection of Claims 6

Claim 6 depends from claim 4 and further requires the software comprises one contiguous portion of JavaScript. The office action argues that the limitations of claim 6 fails to further limit the method claims. Appellants disagree. Claim 6 is dependent from claim 4, which in turn is dependent from claim 3, which depends from claim 2. Dependent claim 2 requires providing the software to the billing portal, and claim 6 further defines the software as comprising one contiguous portion of dynamic JavaScript, as opposed to one contiguous portion

of dynamic HTML as recited in claim 5. Claim 6 recites positive limitations that cannot be ignored. For this reason, the final office action has failed to provide a *prima facie* basis for rejecting claim 5.

The 35 U.S.C. § 103 Rejection of Claims 7

Claim 7 depends from claim 4 and further requires the software to have less than 80 bytes of information when in an uncompressed form. The office action argues that the limitations of claim 7 fails to further limit the method claims. Appellants disagree. Claim 7 is dependent from claim 4, which in turn is dependent from claim 3, which depends from claim 2. Dependent claim 2 requires providing the software to the billing portal, and claim 7 further requires the software to have less than 80 bytes of information when in an uncompressed form. Claim 7 recites positive limitations that cannot be ignored. For this reason, the final office action has failed to provide a *prima facie* basis for rejecting claim 7.

The 35 U.S.C. § 103 Rejection of Claim 8

Claim 8 depends from independent claim 1 and further limits the detailed billing contact information as comprising a URL that directs access to the detailed billing information located on the internet. The office action on page 3 argues, “Moreover, this process would inherently include providing a URL locator.” It is unclear as to what “process” is being referred to on page 3 of the final office action. In relying upon the theory of inherency, however, there must be a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See MPEP 2112, IV. The final office action does not provide a basis in fact and/or technical reasoning for claiming that the “process” would inherently include providing a URL locator that directs access to the detailed billing information located on the internet as required by dependent claim 8. For this reason, the final office action has failed to provide a *prima facie* basis for rejecting claim 8.

The 35 U.S.C. § 103 Rejection of Claim 9

Claim 9 depends from claim 8 and requires the URL to be encrypted and one that authenticates an identity of one accessing information addressable by the URL. The final office action merely alleges it would have been obvious for one to have encrypted the URL locator to prevent fraud there and the like without providing any basis in support thereof. Moreover, the

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final office action appears to ignore the limitation that the claimed URL that authenticates an identity of one accessing information addressable by the URL. For this reason, the final office action has failed to provide a *prima facie* basis for rejecting claim 9.

The 35 U.S.C. § 103 Rejection of Claim 10

Claim 10 depends from independent claim 1 and further requires an act of providing software to the supplier of the summary billing information. This claim was ignored in its entirety in the final office action.

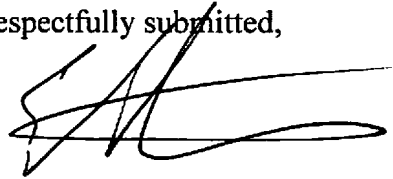
The 35 U.S.C. § 103 Rejection of Claim 11

Claim 11 depends from claim 1 requires the billing information to be received in a first data format and translating the summary billing information from the first data format into another data format. Dependent claim 11 was ignored in its entirety in the final office action.

CONCLUSION

For the above reasons, Appellant respectfully submits that the rejection of pending Claims 1-11 is unfounded. Accordingly, Appellant respectfully requests that the Board reverse the rejections of these claims.

Respectfully submitted,



Eric A. Stephenson
Attorney for Applicants
Reg. No. 38,321
CAMPBELL STEPHENSON LLP
11401 Century Oaks Terrace
Building H, Suite 250
Austin, Texas 78758
Telephone: (512) 439-5093
Facsimile: (512) 439-5099

CLAIM APPENDIX

1. (Previously Presented) A computerized method of providing billing information, comprising:
receiving, over a communications network, a request for summary billing information, the request being automatically generated by a billing portal in response to an action by a billable entity associated with the billing portal;
requesting, over the communications network and in response to said receiving the request for the summary billing information, the summary billing information from a supplier of the summary billing information;
receiving, over the communications network, the summary billing information and detailed billing contact information the supplier of the summary billing information, the detailed billing contact information specifying contact data for detailed billing information; and
transmitting, over the communications network to the billing portal, the summary billing information and the detailed billing contact information, the detailed billing contact information to be usable by the billable entity to access the detailed billing information from a supplier of the detailed billing information.
2. (Previously Presented) The method of claim 1 further comprising:
prior to said receiving the request for the summary billing information, providing software to the billing portal;
wherein on the billing portal the software, in response to the action by the billable entity associated with the billing portal, exclusively causes the billing portal to transmit the request for the summary billing information and to receive the summary billing information and the detailed billing contact information.

3. (Previously Presented) The method of claim 2, wherein said providing the software comprises:
transmitting, over the communications network, the software to the billing portal to effect delivery and installation of the software.
4. (Previously Presented) The method of claim 3, wherein the delivery, the installation, and operation of the provided software are automatic with respect to other human and machine activity at the billing portal.
5. (Previously Presented) The method of claim 4, wherein the software comprises one contiguous portion of dynamic HTML.
6. (Previously Presented) The method of claim 4, wherein the software comprises one contiguous portion of JavaScript.
7. (Previously Presented) The method of claim 4, wherein the software when in an uncompressed form has less than 80 bytes of information.
8. (Previously Presented) The method of claim 1 wherein the detailed billing contact information comprises a Uniform Resource Locator (URL) that directs access to the detailed billing information located on the Internet.
9. (Previously Presented) The method of claim 8 wherein the detailed billing contact information comprises an encrypted Uniform Resource Locator (URL) that authenticates an identity of one accessing information addressable by the Uniform Resource Locator.

10. (Previously Presented) The method of claim 1 further comprising:
prior to said requesting the summary billing information, providing software to
the supplier of the summary billing information;
wherein on the supplier the software, in response to said requesting the summary
billing information, causes the supplier to transmit the summary billing
information over the communications network.
11. (Previously Presented) The method of claim 1, wherein
the summary billing information is received from the supplier of the summary
billing information in a first one of a plurality of different data formats;
and the method further comprises:
translating the summary billing information from the first one of a plurality of
different data formats into a predetermined data format.

12-33. (Canceled)

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None